

Appln No. 09/585,025

Amdt date July 13, 2004

Reply to Office action of February 25, 2004

**REMARKS/ARGUMENTS**

Claims 1-79 are pending. Claims 1, 4, 20-21, 29, 52, and 56 are amended. The Examiner has not considered the Information Disclosure Statement filed on August 6, 2003 because it fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patents. However, Applicants have sent legible copies of all of the references stated in the August 6, 2003 IDS. A copy of the returned postcard acknowledging the receipt of the above-mentioned references by the PTO is enclosed. Nevertheless, for the convenience of the Examiner enclosed is a curtsey copy of the articles of which the Examiner could not obtain. Additional copies of the U.S. Patents, U.S. and European applications will be mailed again, upon Examiner's request.

Claims 4 and 56 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. In view of the amendments to claims 4 and 56, it is respectfully requested that the above-mentioned rejection be withdrawn.

Claims 29-51 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office action alleges that in "claim 29, line 8, the recitation of 'the VBI' lacks antecedent basis." (Office action, page 3, second paragraph.). However, claim 29 does not have the recitation of

**Appln No. 09/585,025**

**Amdt date July 13, 2004**

**Reply to Office action of February 25, 2004**

"the VBI" at all. Accordingly, it is respectfully requested that the above-mentioned rejection be withdrawn.

Claims 1-2, 5, 7-19, 23-25, 27-31, 33-44, 48-50, 52-54, 57-68, 72-74 and 76-77 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kara (US 5,825,893); and claims 3-4, 6, 20-22, 26, 32, 45-47, 51, 55-56, 69-71, 75 and 78-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kara. Applicants submit that all of the pending claims are patentable over the cited references, and reconsideration and allowance of these claims are respectfully requested.

Amended independent claim 1 includes, among other limitations, "a printing wizard for managing the printing of the VBI, wherein the printing wizard determines top, center, or bottom offset, and prints a quality assurance VBI without charging the user."

Kara does not teach or suggest "a printing wizard for managing the printing of the VBI, wherein the printing wizard determines top, center, or bottom offset, and prints a quality assurance VBI without charging the user." The Examiner correctly states that Kara does not disclose "a first GUI for printing a quality assurance VBI." (Office action, page 12, middle of fourth paragraph.). However, the Examiner alleges that "[a]t the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to . . . include a first GUI for printing a quality assurance VBI." (Office action, page 13, second paragraph.).

**Appn No. 09/585,025**

**Amdt date July 13, 2004**

**Reply to Office action of February 25, 2004**

However, the Examiner fails to provide any objective evidence of a motivation to deviate from Kara's specific instructions for selecting a print format, as shown in the cited FIG. 8 of Kara. *In re Kotzab*, 55 USPQ at 1316-1317 ("[e]ven when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.") (emphasis added).

Furthermore, Applicants respectfully assert that a printing wizard for managing the printing of a VBI and determining top, center, or bottom offset is not obvious in view of Kara. The cited Print Format window 804 in FIG. 8 of Kara provides the capability of being able to select a print format such as, a label, an envelop, and the like. However, the claimed limitation of determining top, center, or bottom offset solves a different problem than Kara's Print Format window 804.

Additionally, a printing wizard for printing "a quality assurance VBI without charging the user" is not obvious in view of Kara. Again, the claimed limitation of printing of "a quality assurance VBI without charging the user" solves a different problem than Kara's Print Format window 804. As a result, Kara does not teach or suggest "a printing wizard for managing the printing of the VBI, wherein the printing wizard determines top, center, or bottom offset, and prints a quality assurance VBI without charging the user." Accordingly, independent claim 1 is patentable over Kara.

Amended independent claim 29 includes, among other limitations, "wherein the server subsystem includes an auto

**Appln No. 09/585,025**

**Amdt date July 13, 2004**

**Reply to Office action of February 25, 2004**

update service for verifying whether the user is running a latest software and downloading a new software update to the client subsystem, if there is a new user software."

Kara does not disclose the above-mentioned limitation. The software installation and screen prompts of FIG. 2 and related text in Kara do not describe the above-mentioned term recited in claim 29. Thus, independent claim 29 is not anticipated by Kara.

Amended independent claim 52 includes, among other limitations, "verifying whether the client system is running a latest software;" and "downloading a new software update to the client system, if there is a new client software."

Similarly, the software installation and screen prompts of FIG. 2 and related text in Kara do not disclose "verifying whether the client system is running a latest software; and downloading a new software update to the client system, if there is a new client software." Consequently, independent claim 52 is not anticipated by Kara.

As a result, independent claims 1, 29 and 52 are patentable over Kara. Dependent claims 2-28, 30-51 and 53-79 all depend, directly or indirectly, from their respective independent claims. Therefore, these claims are also patentable over Kara, as being dependent from allowable independent claims 1, 29 and 52, and for the additional limitations they include therein.

Appln No. 09/585,025

Amdt date July 13, 2004

Reply to Office action of February 25, 2004

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is now in condition for allowance, and accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By   
Raymond R. Tabandeh  
Reg. No. 43,945  
626/795-9900

RRT/clv

CLV PAS573394.1--07/13/04 10:27 AM